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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/389,082	09/02/1999	STEPHEN PETER FITZGERALD	104161	4878

25944 7590 07/01/2003

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EXAMINER
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CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/389,082

Applicant(s)

FITZGERALD ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 2, 2003 has been entered.

### *Withdrawal of Rejections from Previous Office Action*

- The rejection of claims 1, 3, 4, 6 and 9-12 under 102(b) over Westhall is withdrawn in view of Applicants' argument that the reference fails to teach projections used to hold the chip in the well. Likewise, the rejection of claims 2, 5, 7, 8, 13 and 15-19 over Westhall in view of Albon is also withdrawn.

### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-3, 6-13 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westhall in view of US patent 5,945,334 to Besemer et al.

Westhall teaches an apparatus for receiving and storing discs. The discs (3) have biologically active substances are bound it. The discs are equivalent to Applicants' chip. The discs are disposed in a tubular receiving element (2). The tubular receiving member is equivalent to Applicants' storage well. According figure 1 of the reference, the discs

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substantially covers the base of the tube, as recited in claim 3. With respect to claim 4, the spacer elements (4) help to retain the discs in the tube. With respect to claim 9, figure 1 of the reference appears to show the tube in the shape of a square. With respect to claim 10, the abstract of the reference teaches the tube being made of plastic. Figure 3 of the reference shows multiple tubes (1) arranged in a line on a flat retainer member (8).

Westhall differs from the instantly claimed invention in that there is no teaching of hot or cold formed projections for holding the chip within the well. Also, there is no teaching of the use of a plurality of stacking trays.

With respect to projections for holding the chip in the well, Besemer et al teach an apparatus for packaging a chip. The chip is a substrate having an array of probes fabricated onto its surface. A body containing a cavity is provided, wherein the chips are disposed within the cavity. The packaging contains a cavity (310) into which the chip is disposed. The packaging is manufactured from injection-molded plastic (col. 6, lines 50-51). Support structures (2115) exist in the packaging to hold the chip in position. See figure 21. The support structure is a projection in the well, which partially covers the chip, as recited in claims 20 and 21. It would have been obvious to one of ordinary skill in the art to incorporate projections onto the wells of Westhall so that the chips will remain in the well in a secure manner.

With respect to the projections being "hot or cold formed", such limitation involves how to make the projection and is not a patentable limitation in claims directed to an apparatus.

With respect to the trays being arranged in a stack, such would have been obvious to one of ordinary skill in the art to allow easier packaging of the wells and easier shipping.

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Therefore, for the reasons set forth above, Applicant's claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Westhall and Besemer et al.

*Response to Arguments*


4. Applicant's arguments filed 6-2-03 have been fully considered but they are not persuasive. Applicants argue, with respect to the retaining means disclosed by Besemer et al, that the reference does not teach the location of the chip within the storage well, such that the chip is surrounded by the walls of the storage well. The Examiner disagrees. In figure 21, the walls (2111) of the well clearly surround the chip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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June 30, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700